

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-18, 20-27, 29, 30, and 34 are presently pending in this case. Claims 1, 8, 17, and 24 are amended and new Claim 34 is added by the present amendment. As amended Claims 1, 8, 17, and 24 and new Claim 34 are supported by the original disclosure,¹ no new matter is added.

In the outstanding Official Action, Claims 1-4, 6, 7-11, 13, and 14 were rejected under 35 U.S.C. §103(a) as unpatentable over Mitsui et al. (U.S. Patent No. 5,626,979, hereinafter “Mitsui”) in view of Victor Company of Japan (Japanese Patent Application Publication No. H1-155654, hereinafter “Victor”) and Ebine (WIPO Patent Application Publication No. WO 03/010840); Claims 5 and 12 were rejected under 35 U.S.C. §103(a) as unpatentable over as Mitsui in view of Victor and Ebine and further in view of Huang (U.S. Patent Application Publication No. 20030027042); Claims 8-13 were rejected under 35 U.S.C. §103(a) as unpatentable over as Mitsui in view of Victor; Claims 15-18, 20, 22-24, 26, 27, 29, and 30 were rejected under 35 U.S.C. §103(a) as unpatentable over Mitsui in view of Victor and Ebine and further in view of Takeshita et al. (U.S. Patent No. 6,521,370, hereinafter “Takeshita”); and Claims 21 and 25 were rejected under 35 U.S.C. §103(a) as unpatentable over Mitsui in view of Victor, Ebine, and Takeshita and further in view of Scharfman et al. (U.S. Patent No. 2,037,827, hereinafter “Scharfman”).

With regard to the rejection of Claims 1 and 8 as unpatentable over Mitsui in view of Victor and Ebine, that rejection is respectfully traversed.

Amended Claim 1 recites in part:

a convex portion projecting in the length direction from
an end surface of the case and extending in the width direction

¹See, e.g., Figures 1 and 11 and paragraph 48 of the publication of the specification.

along the end surface of the case, the convex portion disposed in a distance in the thickness direction from the battery-side terminal, the convex portion being located on a same end surface of the case as the battery-side terminal and extending in the width direction of the case a distance greater than a distance that the battery-side terminal extends in the width direction of case, and *the convex portion projecting in the length direction away from an outermost end surface of the case a distance greater than a distance any other portion of the battery apparatus extends in the length direction.*

The outstanding Office Action conceded that Mitsui and Victor do not describe “a convex portion” as recited in Claim 1, and cited a combination of terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 of Ebine as describing this feature.² However, the figures of Ebine, specifically Figures 1 and 5, show that the outer surfaces of terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 are flush with the outer surface of battery side terminal 120. Accordingly, even the combination of terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 does not project in the length direction away from the end surface of the case a distance *greater* than a distance any other portion of the battery apparatus extends in the length direction. Thus, the combination of terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 cannot protect the battery side terminal 120 from contaminants the way the claimed convex portion does, as described in paragraph 70 of the publication of the specification. Further, to modify any of the terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 to extend further from the case than any other portion of the battery would cause the battery to no longer fit in the camera. Accordingly, such a modification would make the battery pack 100 of Ebine unsuitable for its intended purpose. Therefore, there can be no suggestion or motivation to make such a modification.

²See the outstanding Office Action at pages 5-6.

Thus, as it is respectfully submitted that the proposed combination does not teach “a convex portion” as defined in amended Claim 1, Claim 1 (and Claims 2-7 and 14-16 dependent therefrom) is patentable over Mitsui in view of Victor and Ebine.

Claim 8 recites in part “a recess groove configured to receive the convex portion of the battery when the battery is mounted in the battery mounting section, the recess groove extending in the width direction of the case a distance greater than a distance that the electrodes of the battery-side terminal extend in the width direction of case, *the recess groove not receiving the battery-side terminal.*”

The outstanding Office Action conceded that Mitsui and Victor do not describe “a recess groove” as recited in Claim 8, and cited overhang portion 17 in Figure 10B of Ebine as describing this feature.³ However, the above highlighted feature was not addressed by the outstanding Office Action. It is again respectfully submitted that overhang portion 17 of Ebine also receives the battery side terminal 120. Accordingly, overhang portion 17 cannot be “a recess portion” as defined in Claim 8. Further, to modify overhang portion 17 such that it no longer receives battery side terminal 120 would cause the battery to no longer fit in the camera. Accordingly, such a modification would make the device of Ebine unsuitable for its intended purpose. Therefore, there can be no suggestion or motivation to make such a modification.

Thus, as it is respectfully submitted that proposed combination does not teach “a recess groove” as defined in amended Claim 8, Claim 8 (and Claims 9-13 dependent therefrom) is also patentable over Mitsui in view of Victor and Ebine.

With regard to the rejection of Claims 17 and 24 as unpatentable over Victor in view of Mitsui and Ebine and further in view of Takeshita, that rejection is respectfully traversed.

Amended Claims 17 and 24 also recite in part:

³See the outstanding Office Action at page 18.

a ... convex portion projecting in the length direction from an end surface of the case and extending in the width direction along the end surface of the case, the ... convex portion disposed in a distance in the thickness direction from the battery-side terminal, and the convex portion being located on a same end surface of the case as the battery-side terminal and extending in the width direction of the case a distance greater than a distance that the battery-side terminal extends in the width direction of case, and *the convex portion projecting in the length direction away from an outermost end surface of the case a distance greater than a distance any other portion of the battery apparatus extends in the length direction.*

The outstanding Office Action conceded that Takeshita, Victor, and Mitsui do not describe “a convex portion” as recited in Claims 17 and 24, and cited Ebine as describing this feature as asserted with respect to Claim 1.⁴ However, as noted above, the outer surfaces of terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 are flush with the outer surface of battery side terminal 120. Accordingly, even the combination of terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 does not project in the length direction away from the end surface of the case a distance *greater* than a distance any other portion of the battery apparatus extends in the length direction. Thus, the combination of terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 cannot protect the battery side terminal 120 from contaminants the way the claimed convex portion does. Further, to modify any of terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 to extend further from the case than any other portion of the battery would cause the battery to no longer fit in the camera. Accordingly, such a modification would make the battery pack 100 of Ebine unsuitable for its intended purpose. Therefore, there can be no suggestion or motivation to make such a modification.

⁴See the outstanding Office Action at pages 22, 23, 27, and 28.

Thus, as it is respectfully submitted that the proposed combination does not teach a “convex portion” as defined in amended Claims 17 and 24, Claims 17 and 24 (and Claims 18, 20-23, 25-28, 30, 32, and 33 dependent therefrom) are patentable over Mitsui in view of Victor and Ebine and further in view of Takeshita.

With regard to the rejection of Claims 5 and 12 as unpatentable over Mitsui in view of Victor and Ebine and further in view of Huang, it is noted that Claims 5 and 12 are dependent from Claims 1 and 8 and thus are believed to be patentable for at least the reasons discussed above with respect to those claims. Further, it is respectfully submitted that Huang does not cure any of the above-noted deficiencies of Mitsui, Victor, and Ebine. Accordingly, it is respectfully submitted that Claims 5 and 12 are patentable over Mitsui in view of Victor and Ebine and further in view of Huang.

With regard to the rejection of Claims 21 and 25 as unpatentable over Mitsui in view of Victor, Ebine, and Takeshita and further in view of Scharfman, it is noted that Claims 19 and 26 are dependent from Claims 17 and 24 and thus are believed to be patentable for at least the reasons discussed above with respect to those claims. Further, it is respectfully submitted that Scharfman does not cure any of the above-noted deficiencies of Mitsui, Victor, Ebine, and Takeshita. Accordingly, it is respectfully submitted that Claims 21 and 25 are patentable over Mitsui in view of Victor, Ebine, and Takeshita and further in view of Scharfman.

New Claim 34 is supported at least by Figures 1 and 11 and paragraph 48 of the publication of the specification. As new Claim 34 depends from Claim 1, new Claim 34 is patentable for at least the reasons described above with respect to Claim 1. In addition, new Claim 34 recites subject matter that further defines over the cited references. In particular, new Claim 34 recites “said convex portion has a constant thickness in the thickness direction of the case, and said convex portion extends along a straight line in the width direction of the

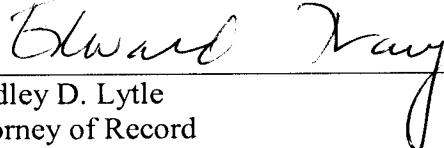
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case.” In contrast, the combination of terminal pressing rib 116, terminal positioning ribs 109, and small projecting bars 110 of Ebine, cited as “a convex portion” in the outstanding Office Action, does not have a constant thickness in the thickness direction of the case and extend along a straight line in the width direction of the case. Accordingly, new Claim 34 further defines over the proposed combination of references.

Accordingly, the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

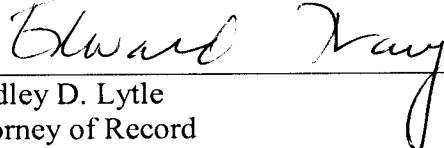
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Bradley D. Lytle

Attorney of Record
Registration No. 40,073



Edward W. Tracy, Jr.
Registration No. 47,998

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)